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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/432,087	11/02/1999	TAKESHI MISAWA	0879-0242P	9612

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BIRCH STEWART KOLASCH & BIRCH LLP  
P O BOX 747  
FALLS CHURCH, VA 220400747

EXAMINER

VORTMAN, ANATOLY

ART UNIT PAPER NUMBER

2835

DATE MAILED: 12/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/432,087		MISAWA, TAKESHI	
	<b>Examiner</b>		<b>Art Unit</b>	
	Anatoly Vortman		2835	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 October 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 and 24-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-17 and 24-31 is/are rejected.
- 7) ☒ Claim(s) 8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All b) ☐ Some \* c) ☐ None of:  
 1. ☐ Certified copies of the priority documents have been received.  
 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
 \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
 a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other:  |

## DETAILED ACTION

### *Amendment*

1. Submission of the amendment filed on 10/16/03 is acknowledged. At this point new claims 24-31 have been added. No claims have been amended. Thus, claims 1-17 and 24-31 are pending in the instant application.

Also, the Examiner has noticed that claim 10 evidently had been inadvertently excluded from consideration on the merits in previous Office Action. Therefore, a Second Non-final Office Action is submitted therein.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. Claims 1-7, 9, 11, 13-16, 24, 25, and 27, are rejected under 35 U.S.C. 102(e) as being anticipated by US/5,880,928 to Ma.

Regarding claims 1, 13, 24 and 25, Ma disclosed (Fig. 1 and 2), a personal computer comprising: a base unit (1); an input part (keyboard) arranged on the base unit, the input part having an operational face (a top side of the keyboard); a display unit (2) having a display face (a

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front side of the display), the display unit being operatively interconnected to the base unit (1) in a state that the display face forms an angle less than 180° with the operational face when the personal computer is in use (the display unit is rotatable and may be positioned at any desirable angle); and a chamber for accepting a removable external device (222 or 212) enhancing a function of the personal computer, the chamber being arranged in (within) the display unit (2), wherein the removable device may be removed without the disassembly of the personal computer.

Regarding the functional recitation that the chamber is *capable or adapted of interchangeably accepting a removable external device*, please note that the aforementioned functional recitations have not been given patentable weight because they are narrative in form. In order to be given patentable weight, a functional recitation must be expressed as a "means" for performing the specified function, as set forth in 35 USC § 112, 6th paragraph, or must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language. *In re Fuller*, 1929 C.D. 172; 388 O.G. 279.

Also, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Regarding claims 2 and 3, Ma disclosed that said display unit (2) is capable of closing the display face and the operation face when the personal computer is not in use, (Fig. 1).

Regarding claims 4 and 5, Ma disclosed that said display unit (2) is hinged and rigidly joined to the base unit (1) in the state that the display face forms the angle less than 180° with the operational face, (Fig. 1).

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Regarding claim 6, Ma disclosed that the chamber opens (22) at topside of the display unit (2), (Fig. 1).

Regarding claim 7, Ma disclosed that chamber opens (21) at a lateral side of the display unit (2), (Fig. 1).

Regarding claim 9, Ma disclosed a keyboard, (Fig. 2).

Regarding claims 11 and 27, Ma disclosed a camera (222), which interacts with the personal computer, when inserted in the slot.

Regarding claim 15, Ma disclosed (Fig. 1 and 2), an apparatus for interfacing a computer with a removable external device (222 or 212), the apparatus comprising: a display unit (2) having a display face (a front side of the display) and being movably coupled to a base unit such that the display face forms an angle generally less than 180° with the base unit (the display unit is rotatable and may be positioned at any desirable angle); and a chamber having a predetermined depth, the chamber disposed in the display unit (2), the chamber having an electrical connection (connecting wires positioned at the bottom of the chambers as shown on Fig. 1) in an innermost recess thereof, the chamber configured to accept at least a portion of the removable external device (222 or 212) such that an electrical connection can be established between the computer and the removable external device (Fig. 1).

Regarding the recitation that the *chamber configured to accept at least a portion of the removable external device*, the aforementioned functional recitation has not been given patentable weight because it is narrative in form. In order to be given patentable weight, a functional recitation must be expressed as a "means" for performing the specified function, as set forth in 35 USC § 112, 6th paragraph, or must be supported by recitation in the claim of

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sufficient structure to warrant the presence of the functional language. *In re Fuller*, 1929 C.D. 172; 388 O.G. 279.

Regarding claim 16, Ma disclosed, (Fig. 1 and 2), an apparatus for interfacing a computer with a removable external device (212 or 222), the apparatus comprising: a display unit (2) having a display face (a front side of the display) and being movably coupled to a base unit such that the display face forms an angle generally less than 180° with the base unit (the display unit is rotatable and may be positioned at any desirable angle); and a chamber formed inside the display unit (2), the chamber having walls capable of covering the bottom side, a left and right side, and a front and back side of the removable external device (212 or 222), the chamber having an opening disposed on the outside of the display unit (21 or 22) configured to receive the removable external device (212 or 222), (Fig. 1).

Regarding the recitation that the display unit *configured to adaptably receive the removable external device*, the aforementioned functional recitation has not been given patentable weight because it is narrative in form. In order to be given patentable weight, a functional recitation must be expressed as a "means" for performing the specified function, as set forth in 35 USC § 112, 6th paragraph, or must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language. *In re Fuller*, 1929 C.D. 172; 388 O.G. 279.

Regarding claim 14 the method steps recited in the claim are inherently necessitated by the device structure as Ma discloses it.

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4. Claim 17, 29, and 30, are rejected under 35 U.S.C. 102(e) as being clearly anticipated by US/5786983 to Brenner et al.. (Brenner).

Regarding claim 17, Brenner disclosed a computer structure (Fig. 1 and 7) which inherently necessitates the method steps recited in the claims, including: forming a chamber (146) inside a display unit (102) coupled to the computer, the display unit (102) having a display face (122) and being movably coupled to a base unit (114) such that the display face (122) forms an angle generally less than 180° with the base unit (114), and the chamber having walls (inherently) for covering a bottom side, a right and left side, and a front and back side of the removable external device (116), wherein the chamber (146) is configured to receive the removable external device (116); and forming an opening associated with the chamber such that only the opening of the chamber is disposed on the outside of the display unit (102).

Regarding claim 29, Brenner disclosed that an input part (120) having an operation face is arranged on the base unit (114).

Regarding claim 30, the functional recitations: "the display unit is capable of closing the display face when the personal computer is not in use" have not been given patentable weight because they are narrative in form. In order to be given patentable weight, a functional recitation must be expressed as a "means" for performing the specified function, as set forth in 35 USC § 112, 6th paragraph, or must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language. *In re Fuller*, 1929 C.D. 172; 388 O.G. 279.

Also, it has been held that the recitation that an element is "adapted to" / "capable of" perform / performing a function is not a positive limitation but only requires the ability to so

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perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

5. Claim 31 is rejected under 35 U.S.C. 102(b) as being anticipated by US/5,801,919 to Griencewic.

Griencewic disclosed (Fig. 10, 11) a device (128) for interacting with a personal computing apparatus, the device comprising: a portion (142) for removably and electrically connecting to a personal computer; and a camera (120) positioned opposite of the portion for removably electrically connecting to the personal computer on the device (128), wherein when the device is interacting with the personal computer, a view from the lens of the camera is substantially perpendicular to a direction of insertion of the device into the personal computer (Fig. 11).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 12 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ma in view of US/5,768,163 to Smith, II (Smith).

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Regarding claims 12 and 28, Ma disclosed all of the claim limitations as apply to claim 1, but did not disclose that said external device is a wireless communication device which interacts with the personal computer when inserted in the slot.

Smith disclosed (Fig. 15) an external device (82) for portable computer, said external device (82) comprising a wireless communication device (84), which interacts with the computer.

Since the invention of Ma and Smith are from the same field of endeavor (portable computers), the purpose of said wireless communication device disclosed by Smith would be recognized in the invention of Ma.

It would have been obvious to a person of ordinary skill in the portable computer art at the time the invention was made to use the wireless communication device as taught by Smith instead of said external device (212 or 222) in the portable computer of Ma, in order to provide said portable computer of Ma with remote control capabilities (Smith, column 6, lines 6+).

Claims 10 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ma in view of US/5786983 to Brenner et al.. (Brenner).

Regarding claims 10 and 26, Ma disclosed all of the claims limitations as apply to claim 1, but did not disclose that said removable device is memory card.

Brenner disclosed a personal portable computer (Fig. 1) having a display unit (110) with removable memory cards (116), (column 6, lines 17-20), wherein said memory cards being insertable in slots in said display unit (110) for interaction with the computer.

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Since inventions of Ma and of Brenner are from the same field of endeavor (personal portable computers), the purpose of removable memory cards disclosed by Brenner would be recognized in the invention of Ma.

It would have been obvious to a person of ordinary skill in the computer art at the time the invention was made to supplement said computer of Ma with removable memory cards as taught by Brenner in order to enhance the versatility and to augment capabilities of the Ma computer.

*Allowable Subject Matter*

8. Claim 31 is allowed.

9. Claims 8 and 29, are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

Regarding claim 8, the claim recites a cutout part and a transparent part positioned so, that when the external device inserted in the chamber, it would have been visible through said transparent part;

Regarding claim 29, the claim recites "an input part arranged on the base unit";

Regarding claim 31, the claim recites: "the lens of the camera is substantially perpendicular to a direction of insertion of the device into the personal computer".

The aforementioned limitations in combination with all remaining limitations of the respective claims are believed to render the subject matter of the aforementioned claims patentable over the art of record.

### *Response to Arguments*

10. Applicant's arguments filed on 10/16/03 have been fully considered but they are not persuasive.

The main thrust of the Applicant's arguments is directed to the assertion that "Examiner's interpretation of the word "removable" as set forth in the claim is overly broad". The Examiner would like to direct the Applicant's attention to the fact that "during patent examination the pending claims must be interpreted as broadly as their terms reasonably allow...." (MPEP 2106 (II) (C)). As such, the Examiner believes that interpretation of the term "removable" is correct.

### *Conclusion*

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anatoly Vortman whose telephone number is 703-308-7824. The examiner can normally be reached on Monday-Friday, between 9:30am and 6:00 pm..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Darren Schuberg can be reached on 703-308-4815. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1782.

A.V.

A handwritten signature in black ink, appearing to read 'A. Vortman', with a long horizontal flourish extending to the right.

Anatoly Vortman  
Primary Examiner  
Art Unit 2835